

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No.	: 10/578,037	Confirmation No.	: 5332
First Named Inventor	: David DILLON		
Filed	: November 03, 2004		
TC/A.U.	: 3621		
Examiner	: Jamie R. Kucab		
Docket No.	: 102980.58649US2		
Title	: Authentication and Tracking System		

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Sir:

Appellant requests review of the final rejection set forth in the Office Action dated December 1, 2010. No amendments are being filed with this Request, and this Request is being filed with a Notice of Appeal. Appellant requests a one month extension of time and is submitting the appropriate fee with this Request.

I. The Combination of Doljack and Brogger Does Not Render Independent Claims 21, 59 and 71 Obviousness

The rejection of independent claims 21, 59 and 71 is based on incorporating a disclosure from Brogger into Doljack that would make the system of Doljack less efficient without any attendant advantages and would not result in a system that operates as required by Appellant's independent claims.

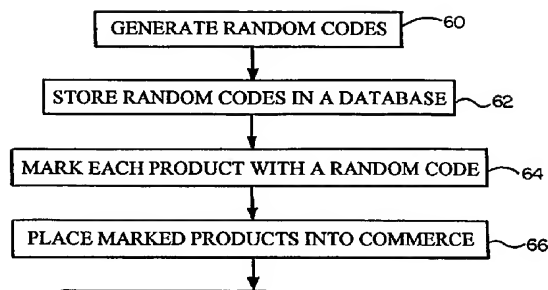
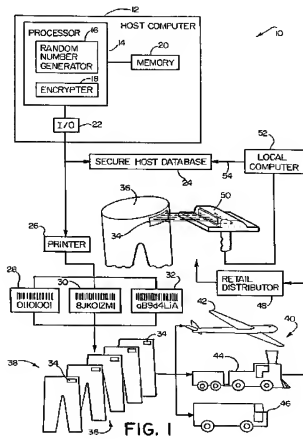
A. Appellant's Disclose and Claim a Novel and Inventive Technique for Protecting the Integrity of Generated Codes

Independent claims 21, 59 and 71 involve, among other things, the "conception" and "birth" technique discussed during the personal interview and described at page 11, lines 11-26 of the present application. The conception of the code is achieved by marking each of a quantity of the instantiations with one of the code strings of the subset. The code is then "born" by capturing the one or more code strings marked on each of the quantity of instantiations and storing the captured one or more code strings within the database on the secure server. This technique has a number of advantages, none of which are recognized by the prior art. For example, situations can occur where not every originally generated unique code is used, for example, due to failure of the label application machinery. This can result in codes being included in a database as valid codes even when the codes are not actually

included on a product. These “valid” codes could then be used on counterfeit products. This is avoided using the “conception” and “birth” technique of independent claims 21, 59 and 71 because only those codes that are actually marked on instantiations are actually included in the database against which codes are validated. Thus, for example, in independent claim 21 each of a quantity of instantiations are marked with one of the code strings, and then the marked code strings are captured and stored in a database on a secure server.

B. Doljack’s System Marks Products Using Previously Stored Codes

Unlike the claimed “conception” and “birth” solution of the present invention in which a subset of codes are first marked on an instantiation of a product and then captured and stored, the system of Doljack first stores the codes and then marks products. Thus, FIG. 1 of Doljack (reproduced on the lower left) illustrates codes from host computer 12 being sent to printer 26, which prints labels 28-32 for marking on instantiations of products 36. Similarly, FIG. 2 of Doljack (a portion of which is reproduced on the lower right) describes that the method first stores generated random codes (step 62) and then marks the instantiations of the products with the stored codes (step 64).



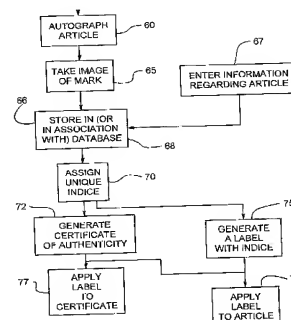
Thus, a counterfeiter can defeat Doljack’s system by either stealing labels before they are placed on products, using codes that are stored in the database but not yet printed on labels or using codes that were printed on labels but were discarded because of a failure of the labeling machinery, all of which are prevented with the novel and inventive conception and birth technique of the present invention.

Doljack assumes that a counterfeiter cannot randomly guess codes stored in the database, and only considers that the system can be defeated by counterfeiters copying codes from products at retail outlets.¹ Thus, Doljack not only fails to disclose the “conception” and “birth” technique recited in the independent claims, but Doljack’s failure to recognize the problem addressed by the “conception” and “birth” technique means that such a technique is not obvious in view of the disclosure of Doljack.

C. Brogger’s System Marks Individually Unique Articles

Brogger is directed to marking articles that are individually unique, such as “sports and celebrity memorabilia.”² This type of system is much different from that of Doljack and the present invention, which are directed to marking a number of instantiations of a particular product, such as the instantiations of a particular brand of pants illustrated in FIG. 1 of Doljack. Thus, to the extent that one skilled in the art would have looked to the system of Brogger to modify that of Doljack, the differences in these systems must be considered when determining whether it would have been obvious to incorporate aspects of Brogger’s system into Doljack.

Because Brogger is directed to individually unique products, the system first captures an image of the product (step 65) and then assigns a unique indice to the product (step 70), generates a label with the unique indice (step 75) and applies the label to the article (step 76).³ This entire process is presumably repeated for each article.



Brogger discusses two alternative orders for the assignment of an indice to an article, the printing of the label and the storage of the indices in a database:

1. Generating label with indice, placing the label on an article and storing the information in a database; and
2. Assigning the indice to an article and then printing the label.⁴

¹ See, for example, column 9, lines 10-48.

² Paragraph 0003.

³ See Fig. 3 (reproduced on the right).

⁴ Paragraph 0040.

Although Brogger is not explicit on this point, it is believed that the second alternative would use an indice that is previously stored in the database.

D. Brogger's Disclosure of the Interchangeability of the Order of Marking Articles and Storing Indices is Not Applicable to Doljack's System

The rejection relies upon Brogger's disclosure of these two processes as alternatives to support the conclusion that it would have been obvious to modify Doljack to incorporate the first alternative. Specifically, the rejection states that the description of these two processes as alternatives means that the ordering of the steps is interchangeable. Although this may be true in the system of Brogger that is concerned with marking individually unique articles, there is no evidence that this would be similarly true in the system of Doljack that is concerned with marking a number of instantiations of a product.

When, as in the case of Brogger, one is concerned with marking individually unique articles, there is appears to be no significant difference in the amount of time it takes to first marking an article and then storing the indice in a database versus first assigning the indice and then marking the article. When, however, one considers marking many articles, such as one hundred million disclosed in Doljack⁵, significant differences arise because it would take much more time to generate the label, place it on the article and then store the information in the database for each of the one hundred million products compared to simply labeling products using previously stored codes.

Because the final rejection provides no stated advantages to modifying Doljack by Brogger to make the system of Doljack operate in a less efficient manner, there is no evidence in the record to support that one skilled in the art would have found this to be obvious. Thus, one skilled in the art would have modified Doljack to use the second option of Brogger, i.e., use pre-stored codes to print the labels that are then placed on products, because this is the most efficient way to label a large number of products. The lack of a disclosed advantage of either order in Brogger would actually result in no modification to the

⁵ See, for example, column 8, line 65-67 – "suppose that a manufacturer wishes to mark 100 million similar products to verify their authenticity."

order disclosed in Doljack. Otherwise, if Doljack were modified to employ the first option of Brogger, the system of Doljack would become less efficient for no apparent advantage. Clearly, one skilled in the art would not find it obvious to modify a process to make it less efficient for no apparent advantage.

Although this argument was provided in Appellant's response to the final rejection, the Advisory Action does not address this argument. As such, there is no evidence in the record for the Board of Appeals to rely upon to affirm the conclusion of obviousness.

E. Combining Doljack and Brogger in the Manner Described in the Final Rejection Would not Result in Appellant's Claimed Invention

If Doljack were modified to include the first option of Brogger, this would result in generating a label with an indice, placing the label on a product and storing the information in a database on a per-product basis. In contrast, Appellant's independent claims recite that each of a *quantity* of instantiations are marked with code strings, the code strings on each of the *quantity* are captured and stored. Thus, even if one skilled in the art were motivated to combine Doljack and Brogger, the resultant combination would not result in the claimed invention.

Although this argument was provided in Appellant's response to the final rejection, the Advisory Action does not address this argument. As such, there is no evidence in the record for the Board of Appeals to rely upon to affirm the conclusion of obviousness.

F. Conclusion

Because one skilled in the art would not have been motivated to modify Doljack to become less efficient and even if one skilled in the art were motivated to combine Doljack and Brogger the combination would not result in what is recited in the independent claims, the combination of Doljack and Brogger does not render the independent claims obvious.

March 31, 2011

Respectfully submitted,

/Stephen W. Palan, Reg. No. 43,420/
Stephen W. Palan
Registration No. 43,420